

Appln. No. 09/925,072
Amdt/Rsp filed February 1, 2006
replying to Office Action mailed August 1, 2005

PATENT
Customer No. 22,852
Attorney Docket No. 7451.0003-02
Intertrust Ref. No. IT-9.2 (US)

REMARKS / ARGUMENTS

In response to the Office Action mailed August 1, 2005 (the "Office Action"), Applicants respectfully request that the Office enter the amendments set forth and consider the following remarks. By this response, claims 44-45 and 47-48 have been amended, and new claims 50-63 have been added. After entry of this paper, claims 44-63 will be pending in this application.

In the Office Action, the Examiner: (i) rejected claims 44-49 under 35 U.S.C. § 112, second paragraph, as being indefinite; and (ii) rejected claims 44-49 under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 5,692,047 to McManis ("McManis").

Applicants respectfully request reconsideration of the above rejections for the reasons set forth below.

Rejection of Claims Under 35 U.S.C. § 112

Claims 44-49 were rejected under 35 U.S.C. § 112 as being indefinite. Specifically, the Examiner objected to the phrase "adequately describing the specification" in claim 44. Although Applicants respectfully disagree with this rejection, in order to expedite prosecution Applicants have deleted the material identified by the Examiner, and thus respectfully submit that this rejection has been overcome.

Rejection of Claims Under 35 U.S.C. § 102(a)

Claims 44-49 were rejected under 35 U.S.C. § 102(a) as being anticipated by McManis. Applicants respectfully submit that the pending claims are allowable over McManis for at least the reasons set forth below.

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In particular, Applicants respectfully submit that McManis does not teach, *inter alia*, at a certification authority, generating a specification describing the actual operation of an executable program based on the results of testing the executable program.

Although McManis refers to the process of checking the integrity of a program to determine if it meets "predefined integrity criteria" (see, e.g., McManis at col. 4, lines 22-28; col. 5, lines 15-27; and col. 7, lines 1-14), McManis does not teach the generation of a specification describing the actual operation of an executable program. That is, in McManis, the predefined integrity criteria, against which programs are checked, are defined in advance of such programs being written and/or without reference to the actual operation of such programs. The predefined integrity criteria thus represents a standard, defined in advance and/or without reference to a specific program, specifying desired characteristics that programs should have.

In contrast, claim 44 recites the generation of a specification that describes the **actual operation** of an executable program, based on the results of testing the executable program itself. The specification recited in claim 44 is not "predefined," as described in McManis; instead, the specification recited in claim 44 is generated after the executable program is written, and describes the **actual operation** of the executable program, as determined by testing, as opposed to the *desired* operation of executable programs in general, as described in McManis.

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In sum, McManis does not teach generating a specification describing the actual operation of an executable program based on the results of testing the executable program. For at least these reasons, Applicants respectfully submit that claim 44 is not anticipated by McManis.

Claims 45-49 are dependent on claim 44, and are thus allowable for at least the reasons set forth above in connection with claim 44.

Claim Amendments

Claim 45 was amended to correct a typographical error and claims 47 and 48 were amended to improve readability. These amendments were not made for purposes of patentability.

New Claims 50-63

Additionally, Applicants submit that new claims 50-63 do not raise new issues, present new matter, or necessitate a new search. Specifically, new claims 50-53 are dependent claims that recite subject matter from either previously presented claims or features of the specification already considered. New claims 54-63 are computer readable medium or systems claims consistent with the recitations of method claims 44-53 and/or features of the application already under consideration. Therefore, new claims 50-63 entail no new issues, matter or search. Furthermore, new claims 50-53 directly or indirectly depend on claim 44, and are patentable for at least the same reasons stated above. New claims 54-63 are patentable, *inter alia*, because they include recitations the same as or similar to those discussed above as distinguishing the

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claimed subject matter from McManis. Thus, the subject matter of new claims 50-63 has already been before the Office, no new matter or issues are presented, and they are patentable over the art of record. Accordingly, Applicants respectfully request allowance of new claims 50-63.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that the pending claims are in allowable form, and respectfully request reconsideration and timely allowance of the pending claims.


Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

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Dated: February 1, 2006

By: _____


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